REMARKS

Claims 1-27 are currently pending in the application, with claims 1, 9, 13, 16 and 23 being independent. Claims 1, 9, 13, 16 and 23 have been amended to more appropriately define the present invention. Applicant requests reconsideration in light of the remarks and claim amendments presented herein, and earnestly solicits timely allowance of the pending claims.

Applicant's Record of Substance of Examiner Interview

On April 12, 2005, Applicant's representatives, J. Voisinet and C. Voisinet, met with Examiners P. Smith and S. Shah to conduct a personal interview. During the interview, a brief demonstration of optical pen technology was provided. Claims 1-27 were discussed and distinctions were presented regarding the pending claims and the cited references *Flickinger* and *Sekendur*. Additionally, Applicant's representatives discussed the Examiner's alleged motivation to combine cited references *Sekendur* and *Flickinger*. Applicant wishes to thank the Examiner for the courtesy of extending a personal interview.

Claim Rejections – 35 U.S.C. §103

The Examiner rejected claims 1-27 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5, 629, 499 to *Flickinger* et al. ("Flickinger") in view of U.S. Patent No. 5,477.012 to *Sekendur* ("Sekendur"). Applicant submits that Examiner has failed to establish a *prima facie* case of obviousness and traverse this rejection.

Sekendur discusses an electronic apparatus, and describes storing and transfering written information (abstract). The apparatus includes a board 102 and a stylus such as a

pen 104. The board 102 is activated when the tip of the pen 104 is in close proximity to the board. The board 102 includes a digitizing tablet 138 with a sensing mechanism 101 constantly generating an electromagnetic field. Once the tip of the pen 104 is in close proximity to the board 102, the electromagnetic field causes sensing of the tip, and the board is activated. The location of the tip of the pen is registered by the sensing mechanism 102, and stored in a memory device in the board. (see col. 2, lines 45-65.) To record information with the device, the user may pick up the board 102 and a piece of paper such as a form, as shown in Fig. 5. Then the user performs certain operations that may directly or indirectly create an indication that the form has been positioned on the board 102. (col. 3, lines 17-21.) One indication method is that form 200 has an identifier, which designates a specific type of form. These identifiers may be prestored in memory 106 for identifying different types of forms. (see col. 3, lines 43-59.)

Conversely, *Flickinger* fails to teach or suggest, at least, "a position coding pattern located on the surface and detectable by an optical sensor, wherein the position coding pattern utilizes displacements of dots in relation to a raster to code different symbol values," as recited in claim 1 (emphasis added); and "printing on a surface a position coding pattern detectable by an optical sensor, wherein the position encoding pattern utilizes displacements of dots in relation to a raster to code different symbol values," as recited in claim 9 (emphasis added); and "on a surface having a position coding pattern detectable by an optical sensor, wherein the position coding pattern utilizes displacements of dots in relation to a raster to code different symbol values," as recited in claim 13 (emphasis added); and "receiving from an optical sensor position data...a surface having a position coding pattern detectable by an optical sensor, wherein the position coding pattern utilizes

displacements of dots in relation to a raster to code different symbol values," as recited in claim 16 (emphasis added); and "providing a user with a form...wherein the form further includes preprinted information in the background thereof, wherein the preprinted coding information utilizes the displacement of dots in relation to a raster to code different symbol values," as recited in claim 23 (emphasis added).

Sekendur fails to cure the deficiencies of *Flickinger* in this respect. *Sekendur* merely discloses a coordinate sensor for detecting the position of a movable detector relative to a data space coded with coordinate information by detecting and processing the coordinate information. This may be used for obtaining both two- and three-dimensional position-related information, such as might be used for determining the position of a pen/pencil on paper for handwriting data input (abstract). *Sekendur* discloses a stylus having an internal sensor and light source, which reads a surface formatted with a position-related coding means. (see col. 4, lines 15-27.) With respect to the position coding, *Sekendur* discloses a surface systematically coded with a plurality of dots designating coordinates. Each dot, as shown in Fig. 1, is divided into three concentric circles partitioned into quadrants. The center circle forms a small dot, while the other circles form inner and outer concentric rings. Each quadrant of each ring represents a digit of a 4-digit number and is further divided into four equal slices, the upper right quadrant of the first digit moving clockwise. The outer ring represents the X-coordinate and the inner ring represents the Y-coordinate. A combination of dark and light slices in the rings of each dot indicates an X-Y coordinate. (see col. 4, lines 28-41.) Alternatively, *Sekendur* discloses a barcode system showing Fig. 4, or a system of checkerboard-like cubes as shown in Fig. 5. (see col. 4, lines 46-48.) *Sekendur* is distinguished from the features quoted above in the pending claims at least in how

positions are encoded onto the surface.

Accordingly, Applicant respectfully requests the Examiner to withdraw the rejections to independent claims 1, 9, 13, 16 and 23. Claims 2-8 depend from claim 1 and are at least allowable by virtue of their dependency from allowable claim 1. Claims 10-12 depend from claim 9 and are allowable at least by virtue of their dependency from allowable claim 9. Claims 14 and 15 depend from claim 13 and are at least allowable by virtue of their dependency from allowable claim 13. Claims 17-22 depend from claim 16 and are allowable at least by virtue of their dependency from allowable claim 16. Claims 24-27 depend from claim 23 and are allowable at least by virtue of their dependency from allowable claim 23.

Moreover, Applicant respectfully submit the Examiner has not provided sufficient motivation for combining the teachings of *Flickinger* and *Sekendur*. Specifically, it would be improper to modify the teachings of *Flickinger* by the teachings of *Sekendur*. Because *Flickinger* determines the position of a stylus using an electromagnetic sensing tablet, modifying the teachings of *Flickinger* by the teachings of *Sekendur* would change the principle of operation by which *Flickinger* senses position.

"If the proposed modification or combination of the prior art would change the principle operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See MPEP §2143.02. Because *Flickinger* uses an electromagnetic sensing mechanism to determine position, there would be no reason to provide a surface which has a position-related coding means. Moreover, the stylus of *Flickinger* would also have to be modified in order to take advantage of the teachings of

Sekendur to be able to utilize the position-related coding means. By performing these modifications to the teachings of *Flickinger*, one would change its principle of operation.

Conclusion

In view of the above amendments and remarks, this application appears to be in condition for allowance and the Examiner is, therefore, requested to reexamine the application and pass the claims to issue.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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